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EXAMINER

VAUGHAN, MICHAEL R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/580,997
Filing Date: May 26, 2006
Appellant(s): MADAR ET AL.

Reitseng Lin
Reg. No. 42,804
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/4/11 appealing from the Office action mailed 6/7/11.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-20.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

JP 2003-132624	Tsurui	05-2003
US 2002/0146238	Sugahara	10-2002
USP 6,469,718	Setogawa	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Patent Publication 2003-132624 to **Tsurui** in view of USP Application Publication 2002/0146238 to **Sugahara** and USP 6,469,718 to **Setogawa** et al., hereinafter **Setogawa**.

As per claims 1 and 8, Tsurui teaches a method and a digital recording and playback apparatus comprising:

enabling a user to record digital signals onto a digital storage medium in a first program chain for password protection said first program chain being a single program chain according to DVD specifications (0030-0031);

receiving a password from said user for said selected recording title (0033);

storing said password for said selected recording title on said digital storage medium (0051);

storing a password menu screen for said selected recording title on said digital storage medium (0033-36) wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (0047); and

requiring said password to be input before playing back said selected recording title (0030). Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post

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command (0042). Therefore Tsurui is silent in disclosing storing the selected recording title, the password menu, and the password in a single PGC. Tsurui teaches several program chains linking to each other in order to carry out the password entry for the selected recording title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password, address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the selected title (program number), relative address (pointer to the video content), and the password for that number are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC, with its cells, could store the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with the title in a single program chain. This just leaves the location of the password menu. Prior art Setogawa further teaches that using a single program chain is more efficient

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than a plurality of program chains because access time is decreased with the PGC data including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already teaches the password is stored with the menu (0037) and Sugahara teaches the password can be stored with the title in a single program chain. Thus incorporating the fact that it is more efficient to store everything in one program chain, one of ordinary skill in the art could have tried storing the title, password, and menu in one program chain. As long as doing so does not conflict the DVD specification, there are no unpredictable results. All three references operate within the DVD specification. After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense. Tsurui clearly shows it is possible to do so while adhering to the DVD specification. Moreover, because a program chain is simply made up of any number of cells, the very nature of a chain with links obviously lends itself to the idea that one could simply make a longer chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill in the art could not have placed the title, password, and menu in one program chain. As such, the claim is obvious because one of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. Since placing the title, menu, and password leads to anticipated success (less delay while adhering to the DVD specification), it is likely the product not of innovation but of ordinary skill and common sense.

As per claim 16, Tsurui teaches a digital storage medium, comprising:
a plurality of data fields [DVD standard] (0027); and
wherein said data fields comprise a first program chain [PCG#10] for storing a selected recording title the program chain being according to DVD specification (0030).

Tsurui teaches the password is stored in a PGC which includes the program for driving the password input menu (0037) said password menu screen prompts said user to input said password if playback of said selected recording title is attempted (0047). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post command (0042). Therefore Tsurui is silent in disclosing storing the selected recording title, the password menu, and the password in a single PGC. Tsurui teaches several program chains linking to each other in order to carry out the password entry for the selected recording title.

First of all, Tsurui adheres strictly to the DVD specification. Sugahara teaches a similar system in which a PGC which calls list information includes both the password, address of the title, and the title (0088 and 0089). In paragraph 0013-14 Sugahara describes the nature of what PGC do, namely they prescribe the order by which content is displayed. Sugahara teaches that list information blocks perform the same function (0018). The list information even has cells which PCG also have. Clearly list information and PGC are equivalent. What is unique in Sugahara is that both the selected title (program number), relative address (pointer to the video content), and the password for that number are stored in the same cell of a single list information (PGC)

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(0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Only this method yields a more granular means of control over the content. One of ordinary skill could have stored the password in the same single PGC as the title without parting from the invention's purpose. A single PGC, with its cells, could store the password and the title for said title.

Thus the combination of Tsurui clearly shows it is obvious to store password with the title in a single program chain. This just leaves the location of the password menu. Prior art Setogawa further teaches that using a single program chain is more efficient than a plurality of program chains because access time is decreased with the PGC data including menus can be read once sequentially (col. 13, lines 1-15). Tsurui already teaches the password is stored with the menu (0037) and Sugahara teaches the password can be stored with the title in a single program chain. Thus incorporating the fact that it is more efficient to store everything in one program chain, one of ordinary skill in the art could have tried storing the title, password, and menu in one program chain. As long as doing so does not conflict the DVD specification, there are no unpredictable results. All three references operate within the DVD specification. After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense. Tsurui clearly shows it is possible to do so while adhering to the DVD specification. More over, because a program chain is simply made up of any number of cells, the very nature of a

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chain with links obviously lends itself to the idea that one could simply make a longer chain. Absent any unpredictable result, Examiner does not see why one of ordinary skill in the art could not have placed the title, password, and menu in one program chain. As such, the claim is obvious because one of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. Since placing the title, menu, and password leads to anticipated success (less delay while adhering to the DVD specification), it is likely the product not of innovation but of ordinary skill and common sense.

As per claims 2, 9, and 17, Tsurui teaches the digital storage medium is a DVD (0030).

As per claims 3 and 10, Tsurui teaches the step of storing at least one command on said digital storage medium in said first program chain (0071).

As per claims 4 and 11, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040).

As per claims 5 and 7, Tsurui teaches at least one command [commands into collation PGC to check for and guide password entry] is created and stored in response to receiving said password from said user (0035).

As per claim 6, Tsurui teaches wherein said at least one command includes a PRE command according to DVD specification (0041).

As per claims 12, 15, and 19, the combination of Tsuria and Sugahara essentially moves the password and the selected title into a single PGC. Thus, Tsurui teaches creating at least one command [commands into collation PGC to check for and guide password entry] and causes said at least one command to be stored on said digital storage medium in said first program chain in response to an input from said user defining said password (0035). The claim is obvious because this is a predictable result from Tsuria and Sugahara as combined in the rejection of claim 1.

As per claim 13, Tsurui teaches at least one command includes a plurality of commands [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 14, Tsurui a plurality of commands comprise PRE commands according to DVD specifications [chain leads to multiple other commands with there respective pre/post commands; 0042-0046].

As per claim 18, Tsurui teaches said first program chain also stores at least one command [PGC#10; 0046 and Figure 5b].

As per claim 20, Tsurui teaches at least one command causes said password menu screen to be displayed if playback of said selected recording title is attempted (0040) and input of said user-assigned password is required before playing back said selected recording title (0051).

(10) Response to Argument

As per claim 1, Appellant argues that the combination of prior art fails to teach storing the (i) recording title, (ii) title password, and (iii) the password menu screen in a single program chain. This argument is unpersuasive for the following reasons. Tsurui teaches the (ii) password is stored in a PGC which includes the collation program for driving the (iii) password input menu (0037). Tsurui teaches a separate single PGC for playing back the selected title [collation program utilized to play back the picture/audio data; 0030] which is invoked by PGC which calls the video in its post command (0042). It is clearly noted that Tsurui teaches (i), (ii), and (iii) on a recording medium albeit in separate program chains (0038). Tsurui appears to teach the program chain is composed of six program chains (0042). The claim language requires a single program chain. However it is noted, that Tsuria defines the (singular) program chain (0037) having a collation program. Tsuria further teaches the collation program is equipped

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with the password (see claim 1). The collation program is what drives the password menu and checks for the correct password. This collation program is spread out among the post commands of PCG#1-#5 of Figure 5b which gives credence to the notion that there is but one single program chain containing "links" to execute the collation program. A chain is composed of links and adding more links does not create another chain but rather just adds to the one chain. Even combining two separate chains into one, results in a single chain. While it arguable that this can be interpreted to meeting the claim's 1 "single program chain", the secondary references demonstrate that it would have been obvious to one of ordinary skill in the art at the time of the invention to places items (i), (ii), and (iii) into a single program chain.

Sugahara teaches that both the selected title (program number), relative address (pointer to the video content), and the password for that title are stored in the same cell of a single list information (PGC) (0089). Sugahara does this to protect the individual content with a password to prevent others from viewing the content. This is the same reasoning for the passwords of Tsurui. Tsurui already teaches the password is stored with the menu (0037) and Sugahara teaches the password can be stored with the title in a single program chain. Tsuria combines (ii) the title password and (iii) password menu in a program chain (0037). Sugahara combines the (i) recording title and (ii) the title password in a single program chain. Setogawa was relied upon to teach that using a single program chain is more efficient than a plurality of program chains because access time is decreased with the PGC data including menus which rely upon user input can be read once sequentially (col. 13, lines 1-15). The fact that the processing

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delay is reduced when using a single program chain is motivation as to why one of ordinary skill in the art would recognize the value of using a single program chain.

Tsuria already teaches combining items (ii) and (iii) into a program chain and Sugahara teaches combining items (i) and (ii) into a program chain. Coupled with the fact that Setogawa teaches it is more efficient to use a single program chain, it is obvious to combine items (i), (ii), and (iii) into a single program chain.

This combination does not teach away from Tsuria as Appellant suggests. All three references adhere to the DVD specification. Combining separate program chains into one is as simple as adding links to a chain. Each link points to the next link. There is no reason found why one of ordinary skill in the art would seek to avoid combining program chains into one. The prior art actually teaches it is beneficial to do so (Setogawa). Moreover, the during the prosecution history, Appellant has attempted to distinguish the claimed invention by claiming the password menu in a separate program chain from the password/title program chain (see claims filed 5/15/09). Then later, Appellant filed claims using a single program chain (12/07/10). Appellant's specification also shows that either using one program chain or multiple chains are both acceptable alternatives (original filed specification, page 11, lines 12-16). Thus, the references do not teach away from each other. Incorporating items (i), (ii), and (iii) into a single program change is an acceptable alternative which does not yield any unpredictable results.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is noted that only claim 1 was specified in the Appellant's arguments. However since the argued limitation is present in each of the independent claims, the response provided applies to claim 8 and 16 as well.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MICHAEL R VAUGHAN/

Examiner, Art Unit 2431

Conferees:

/Christopher A. Revak/

Primary Examiner, Art Unit 2431

/Syed Zia/

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